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Q&A with Christopher Carani of MCANDREWS, HELD & MALLOY, LTD.

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A picture is worth a thousand words—and considerably more than that in term of profits, licensing fees and damages if it supports a design patent for a new product. That's the message Christopher Carani has for manufacturers and inventors in the sporting goods industry. A partner at the law firm of **McAndrews, Held & Malloy, Ltd.** (www.mhmlaw.com), Carani is a registered attorney before the U.S. Patent and Trademark Office, and an expert in the specialized field of protection and enforcement of product design rights. He discussed with SportsSPIN how individuals and companies can secure, protect and enforce intellectual property rights.



Christopher Carani

Q What is a design patent, and what is it's value in the current marketplace?

A There are basically three types of patents offered in the US: utility, design, and plant. A design patent protects the appearance of an article of manufacture. It may be drawn protect the shape or configuration of an article, the surface ornamentation applied to the article, or a combination of both. In short, design patents protect appearance, utility patents protect function. Both forms of protection can be acquired for a single product.

As for the patent document itself, it basically includes a series of pictures and drawings of the claimed design taken from varying perspectives. Using a learned approach to drafting design patents, significant protection can be attained. All too often, however, there isn't enough thought given to the preparation of design patent applications, and what you end up with is a patent which offers little protection and is easy for competitors to design around. Through the strategic use of some underused drafting techniques, for example, phantom lines, multiple embodiments, and multiple applications, it is possible to attain broad design patent protection.

As for their value in today's global marketplace, design patents are becoming increasingly important. Let's face it: looks matter. Designs transcend language and cultural barriers. Companies recognize this and are investing significant resources to create appealing designs. Remember, most often, a product's outward appearance is the first thing consumers see. Thus, a product's design can be the simplest, most direct manner in which to reach consumers. Further, sometimes a product appearance is the only way to differentiate your product from competitors. Thus, as the importance of design is increasing, companies are investing record resources in this area, with this investment in place



companies desire affordable and practical legal protection.

Design patents not only provide protection, but they also can constitute valuable licensable assets. For example, let's say a tennis racquet company designs a new a tennis racquet handle and that design winds up being an effective handle for, let's say, a fishing rod. Depending on how the design patent is drafted, a tennis racquet company could license its design patent to a fishing rod manufacturer. In short, if drafted properly, design patents can create valuable assets.

Q What protection does a design patent provide?

A A design patent provides the owner of the patent with the right to exclude others from making, using, or selling the same or substantially similar designs in the U.S. Thus, the ultimate test of infringement is whether the accused design and the patented design look substantially similar, and whether the accused design includes the novel features of the patented design. I believe my experience litigating in the design patent context provides unique insight into how to effectively draft these patents and thereby increase the scope and effectiveness of their protection.

As for remedies, injunctions and money damages are available. Damages in design patent cases can be substantial. Unlike damages in utility patent cases, in the design patent context, a patentee can recover the infringer's profits. This is significant. This wrinkle in the law can lead to large judgments if dealing with retail products where profit margins are high. Indeed, recently there has been several multi-million dollar judgments imposed in design patent infringement cases.

Q Is a design patent difficult to secure?

A It really depends on what you are trying to protect. To qualify for design patent protection, the design must be novel, non-obvious and ornamental. When we say ornamental, it doesn't have to be aesthetically pleasing—there just has to be an element of design. There are design patents on screws, nuts and bolts. These are functional items, but nevertheless the patents include elements of design. In contrast, if the design is dictated solely by function, protection will be denied. For example, courts have denied protection to key blades because there was no design. In order to mate with the appropriate lock, the key necessarily had to take that form, thus there was no design element. Perhaps, if the patent was directed at the key handle, which could have taken many forms, the result, in my opinion, would have been different.

Compared to utility patents, design patents can be acquired very quickly and cheaply. On average, it takes about 12 to 14 months for design patents to issue once filed. Even better, using a recent and little known amendment to the patent procedure, an applicant can file an expedited application and the time can be shortened to three or four months. This is a most valuable resource for seasonal manufactures and trend-oriented manufacturers, who can't wait a whole year for protection to issue. As for the cost, an attorney can typically file the design application for about \$1,000-\$2,000.

I caution people from going through the application process on their own. Patent attorneys have to be specifically licensed by the Patent Office. If looking for someone to assist you with securing a design patent, I would not just retain a general patent attorney. Rather, I would advise going a step further and find an attorney who has expertise specifically with product design protection.

Q Aren't design patents on the rise in the U.S.?

A Yes. In 1992, there were 9,000. Last year, the number stood at almost 20,000. Similarly, in China and the E.U., design patents applications are reaching record levels.

Q Why is this?

A I think there are several contributing factors. As I stated earlier, it has a lot to do with the importance of design in reaching consumers in a global market place. Companies want to protect their investments in their designs. There are also more insidious reasons, namely, the deluge of knock-offs being produced overseas, which are coming into the U.S. at record rates, has forced companies to actively seek protection. In my opinion, design patents are the first line of defense against knock-offs. Lastly, in 2000 and 2002, the Supreme Court made two landmark decisions that curbed the use of trademark laws to protect product designs. In its opinions, the Supreme Court basically directed applicants to seek design patents instead of trade dress in order to protect product designs. The effects of these decisions are now being realized.

I also notice that design patents are being more effectively enforced in the courts. For example, my research of published judicial opinions from the last five years indicates that 75% of preliminary injunction motions in design patent cases were granted. Why? I think it's because the test for design patent infringement is relatively simple. Judges feel comfortable with the test. The judge simply compares the appearance of the accused product with the patent design. If the judge determines that there is a substantially similar, the court will typically enter an injunction. In the end, the more often design patents are successfully enforced, the more interested companies are in seeking this protection.

Q What is your advice to inventors and manufacturers of sporting goods?

A Protect yourself. Don't let your company do your competitor's R&D work. If you wait to apply for a design patent until after your product becomes hot, you're most likely be out of luck. With some forethought and an interactive relationship between a company's design department and a patent attorney versed in this area of the law, significant and valuable protection can be attained. For more information, you can contact me or my firm.

Editor's Note

**Christopher Carani
will be a featured speaker
at The Super Show 2005.**

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